

## REMARKS

1. In response to the Office Action mailed May 4, 2006, Applicants respectfully request reconsideration. Claims 1-47 were originally presented for examination. All claims have been rejected in the outstanding Office Action. By the foregoing Amendments, claims 1, 6, 10, 14-17, 21-23, 25-27, 33, 34, 38 and 40-41 have been amended. No claims have been canceled or added. Claims Thus, upon entry of this paper, claims 1-47 will remain pending in this application. Of these forty-seven (47) claims, four (4) claims (claims 1, 27, 34 and 38) are independent. Based on the above Amendments and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

### *Art of Record*

2. Applicants acknowledge receipt of form PTO-892 identifying additional references made of record by the Examiner.
3. Applicants thank the Examiner for returning form PTO/SB/08 filed by Applicants on October 31, 2003 which has been initialed by the Examiner indicating consideration of the reference(s) cited therein.

### *Objections to the Drawings*

4. The Examiner has objected to Figure 3 under 37 CFR § 1.84(p)(5) for including the reference numbers "332A" and "332B", which are not mentioned in the specification. The specification has been amended to modify the generic reference to "arrows 332" in paragraph 43 of Applicants specification to recite "arrows 332A-D." (*See*, Above Amendment to paragraph [0043].) Withdrawal of this objection is, therefore, respectfully requested.

### *Claim Rejections under 35 U.S.C. §101*

5. Independent claim 1 and dependent claims 2-13, 20, 21, 24 and 25 have been rejected under 35 U.S.C §101 because the claimed invention is allegedly directed to non-statutory subject matter. Specifically, the Examiner asserts that the claims lack a useful, concrete, and tangible result and, more specifically, that the claims "do not have the result of creating SDK volumes." (*See*, Office Action at 3 and 4.) Applicants respectfully

disagree, and request that the Examiner reconsider and withdraw the rejection under §101 for at least the following reasons.

6. In contrast to the Examiner's assertion, claim 1 recites a "useful, concrete and tangible result" in its preamble, which recites "[a] system for producing a software distribution kit (SDK) volume, the SDK volume comprising a computer-readable medium storing a plurality of SDK component files." As such, Applicants respectfully submit that claim 1 satisfies the requirements of 35 U.S.C. §101. Applicants further respectfully submit that dependent claims 2-13, 20, 21, 24, and 25 likewise satisfy the requirements of 35 U.S.C. §101. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection under 35 U.S.C. §101.

***Claim Rejections under 35 U.S.C. §103(a)***

7. Independent claims 1 and 27 have been rejected under 35 U.S.C §103(a) as being unpatentable over U.S. Patent No. 6,011,758 to Dockes, *et al.* (hereinafter, "Dockes") in view of Applicant Admitted Prior Art (hereinafter, "AAPA"). Independent claim 34 has been rejected under U.S.C §103(a) as being unpatentable over Dockes in view of AAPA, further in view of U.S. Patent No. 5,822,083 to Ito, *et al.* (hereinafter, "Ito"). Independent claim 38 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Dockes in view of AAPA and further in view of U.S. Patent No. 5,831,950 to Furukawa, *et al.* (hereinafter, "Furukawa"). The Examiner further rejected the dependent claims as being unpatentable over one or more of the above references or further in view of U.S. Patent No. 5,613,097 to Bates, *et al.* (hereinafter, "Bates"); U.S. Patent No. 6,205,450 to Kanome (hereinafter, "Kanome"); U.S. Patent No. 5,963,971 to Fosler, *et al.* (hereinafter, "Fosler"); and/or U.S. Patent No. 5,920,725 to Ma, *et al.* (hereinafter, "Ma"). Based on the above Amendments and following Remarks, Applicants respectfully request that these rejections be reconsidered, and that they be withdrawn.

8. Independent claim 1 recites, in part "at least one normalized file storage server configured to store SDK component files of a plurality of SDK volumes, wherein at least one component file stored by the file storage server is shared by at least two of the plurality of SDK volumes." In rejecting claim 1, the Examiner relied on col. 16 lines 57-61 of Dockes for allegedly disclosing "at least one normalized file storage server." (*See*, Office Action at 5.)

9. Dockes is directed to a system for the production of customized musical compact disks. (*See*, Dockes at Abstract.) The Dockes system comprises a data server that stores musical files for producing the customized compact disks, and a user interface program that can be run on the server to help eliminate duplicate titles (i.e., songs). (*See*, Dockes at col. 9 lns. 61-63; col. 16 lns. 57-61.) Dockes, however, does not disclose that a particular song stored by the server is shared by multiple stored CD audio disks (which the Examiner relied on as allegedly disclosing “SDK volumes”).

10. As such, Applicants respectfully submit that Dockes fails to teach or suggest “at least one normalized file storage server configured to store SDK component files of a plurality of SDK volumes, wherein at least one component file stored by the file storage server is shared by at least two of the plurality of SDK volumes,” as recited in Applicants’ claim 1. Applicants further respectfully submit that AAPA does not cure this defect of Dockes. Applicants accordingly respectfully request that for at least this reason the Examiner reconsider and withdraw the rejection of claim 1.

11. In addition, claim 1, as amended, recites “a file extractor configured to copy SDK component files to the at least one normalized file storage server and determine for a particular SDK component file to be copied, whether the particular SDK component file is already stored by the file storage server and, if not, copy the particular SDK component file to the at least one normalized file storage server.” (*See*, Applicants’ claim 1, above.)

12. Dockes, however, discloses acquiring and storing all files from a CD audio disk being acquired that are specified in a job file. (*See*, Dockes at col. 8 lns. 63-65.) Dockes, however, does not disclose determining whether a particular file is already stored by the system, and, if not, copying that file. As such, Applicants respectfully submit that Dockes fails to teach or suggest “a file extractor configured to copy SDK component files to the at least one normalized file storage server and determine for a particular SDK component file to be copied, whether the particular SDK component file is already stored by the file storage server and, if not, copy the particular SDK component file to the at least one normalized file storage server.” Applicants further respectfully submit that AAPA does not cure this defect. The Examiner relied on AAPA for disclosing a system for producing an SDK. AAPA, however, does not disclose determining whether a particular file is already stored by the system, and, if not, copying the file. Applicants accordingly

respectfully request that the Examiner reconsider and withdraw the rejection to claim 1 for at least this additional reason.

13. Independent claim 27 recites, in part, “wherein at least one SDK component file stored by the means for storing is shared by at least two of the plurality of SDK volumes; ... and means for copying SDK component files to the means for storing, wherein the means for copying comprises means for determining for a particular SDK component file to be copied, whether the particular SDK component file is already stored, and, if not, the particular SDK component file is copied to the at least one normalized file storage server.” Applicants accordingly respectfully submit that independent claim 27 is also in condition for allowance for reasons similar to those discussed above with reference to claim 1.

14. Independent claim 34 recites, in part, “for each of the plurality of SDK component files, if the SDK component file has not already been stored on a file storage server, storing the SDK component file on the file storage server and, if the SDK component file has already been stored on the file storage server, sharing the SDK component file with the SDK volume and at least one other SDK volume.” In rejecting claim 34, the Examiner relied on Ito for allegedly disclosing “if the SDK component file has not already been stored.” Applicants respectfully disagree.

15. Ito is directed to an image storing apparatus. During imaging of a stack of documents, index information is printed on the original document after it is imaged. (*See*, Ito, at col. 3, lns 46-50.) Then, to prevent storing the same document twice, the printed index is read and, if it matches a stored index, a warning is issued that the document has already been imaged. (*See*, Ito at col. 4, lns. 13-19.) Ito, however, does not teach or suggest sharing an imaged document among different volumes.

16. As such, Applicants respectfully submit that Ito fails to teach or suggest “for each of the plurality of SDK component files, if the SDK component file has not already been stored on a file storage server, storing the SDK component file on the file storage server and, if the SDK component file has already been stored on the file storage server, sharing the SDK component file with the SDK volume and at least one other SDK volume,” as recited by claim 34. Applicants further respectfully submit that for at least similar reasons to those discussed above, Dockes and AAPA fail to cure this defect. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection to claim 34.

17. Independent claim 38 recites, in part, “copying the plurality of SDK component files from a file storage server, wherein at least one component file stored by the file storage server is shared by at least two of the plurality of SDK volumes.” Applicants respectfully submit that for at least similar reasons to those discussed above neither Dockes nor AAPA teach or suggest “at least one component file stored by the file storage server ... shared by at least two of the plurality of SDK volumes.” Applicants further submit that Furukawa fails to cure this defect. Particularly, the Examiner relied on Furukawa solely for disclosing creating a CD image prior to producing a CD. Furukawa, however, does not teach or suggest sharing a stored component file by at least two SDK volumes. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection to claim 38.

***The Examiner has Failed to Provide Evidence of a Motivation to Combine***

18. The §103 rejections of claims 1, 4-6, 8, 9, 14, 16, 17, 20-22, and 27 are *prima facie* improper because they provide no appropriate basis for combining Dockes and AAPA. As set forth in the Manual of Patent Examining Procedure (MPEP) at § 706.02(j), “To establish a *prima facie* case of obviousness . . . there must be some suggestion or motivation, ***either in the references themselves or in the knowledge generally available to one of ordinary skill in the art***, to modify the reference or to combine reference teachings (emphasis added) . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success ***must both be found in the prior art and not based on applicant’s disclosure*** (emphasis added). *In re Vaeck*, 947 F.2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”

19. The Office Action attempts to justify combining Dockes with AAPA in rejecting claim 1 based on the following conclusory statement:

It would have been obvious to one of ordinary skill in the art at the time the invention to take the SDK’s from AAPA and install it into the invention of Dockes, thereby offering the obvious advantage of writing not only audio data but also computer data (such as SDKs) expanding the uses of Dockes onto different types of data. This makes a system with more features and more user-friendly. This also, coincidentally, meets the intended use of the claim.

(See, Office Action at pg. 6).

20. The Examiner, however, identifies nothing in the prior art supporting this conclusory statement. As held by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *Also see, In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.”)).

21. As such, because the Examiner has failed to provide any evidence in the prior art of a motivation to combine Dockes and AAPA in the manner claimed, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under §103 for at least this reason. Further, if the Examiner is relying on facts within his own personal knowledge for providing this motivation, Applicants respectfully request that the Examiner provide an affidavit pursuant to 37 C.F.R. §1.104(d)(2) (“[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.”)

22. Similarly, Applicants respectfully submit that the §103 rejections of claims 34, 36, and 37 are *prima facie* improper because they provide no appropriate basis for combining Dockes, AAPA and Ito. The Office Action attempts to justify combining Dockes with AAPA and with Ito in rejecting claim 34 based on the following conclusory statement:

It would have been obvious to one of ordinary skill in the art at the time the invention to take the SDK's from AAPA and the non-duplication of previously stored files/images and install them into the invention of Dockes, thereby offering the obvious advantage of not storing duplicate files then [sic] removing them later with a background process (like Dockes does), but instead not storing them at all further saving storage of Dockes and another obvious advantage of writing not only audio data, but also computer data (such as SDKs)

expanding the uses of Dockes onto different types of data. This makes a system with more features and more user-friendly. This also, coincidentally, meets the intended use of the claim.

(See, Office Action at pg. 25.)

23. Here too the Examiner has failed to provide any evidence in the prior art supporting the Examiner's alleged motivation. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection under §103 for at least this reason.

24. Further, the Examiner is reminded that in order to provide a *prima facie* case of obviousness, the Examiner must provide specific reasons why someone might want to combine the references in the manner claimed. Thus, the Examiner must not only provide evidence of combining Dockes with AAPA in the manner claimed, but the Examiner must also provide evidence of a motivation to combine Ito with Dockes and Ito with AAPA in the manner claimed. Further, if the Examiner intends to rely on facts within his own personal knowledge, Applicants request that Examiner provide an affidavit as required by 37 C.F.R. §1.104(d)(2).

25. Similarly, the Examiner failed to provide any evidence of supporting the Examiner's alleged motivation to combine Dockes, AAPA, and Furukawa in rejecting claims 38 and 44-47 under §103. As such, Applicants respectfully request that, for at least the reasons discussed above, the Examiner reconsider and withdraw the rejection under §103.

26. Applicants further respectfully note that in all remaining §103 rejections, the Examiner has failed to cite to evidence in support of the alleged motivation. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejections for at least this reason. Further, if the Examiner intends to rely on facts within his own personal knowledge, Applicants request that Examiner provide an affidavit as required by 37 C.F.R. §1.104(d)(2).

### ***Dependent Claims***

27. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicant respectfully

requests that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

***Conclusion***

28. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael G. Verga', written over a horizontal line.

Michael G. Verga  
Reg. No. 39,410

July 19, 2006